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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#11
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01/16/97

In re application of:

GREENE *et al.*

Appl. No. 08/469,637

Filed: June 6, 1995

For: **Human Tumor Necrosis Factor
Receptor**

Art Unit: 1812

Examiner: Pak, M.

Atty. Docket: 1488.071000

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Election and Response with Traverse Under 37 C.F.R. § 1.143Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action dated September 30, 1996, applicant provisionally elects, *with traverse*, Group I represented by claims 1-7 for further prosecution. Applicant reserves the right to file one or more divisional applications directed to the non-elected inventions should the restriction requirement be made final.

Remarks

Applicant respectfully traverses the restriction requirement as it applies to Groups I and II. According to the examiner, the polynucleotides of Group I and the polypeptides of Group II are patentably distinct inventions because "the protein of II can be made by protein purification from cells endogenously expressing the protein."

However, even where two inventions alleged by an examiner to be patentably distinct appear in a single application, restriction remains improper unless the examiner can show that the search and examination of both groups would entail a "serious burden" (*see* MPEP § 803). In the present situation, the examiner has clearly failed to make such a showing. Indeed, no arguments have been made explaining why it would impose an undue burden to examine the polynucleotide and polypeptide claims together.

Applicant submits that a search of the polynucleotide claims would clearly provide useful information for the polypeptide claims. This is because the genetic code is known. Moreover, in many if not most publications, where a published nucleotide sequence is an open reading frame, the authors also include, as a matter of routine, the deduced amino acid sequence. Thus, the searches for polynucleotides and polypeptides would clearly be overlapping.

Accordingly, as applied to Groups I and II, the restriction requirement should be withdrawn.

Respectfully submitted,

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